UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,604	08/01/2000	MASOOD GARAHI	ODS-23	8445

75563 7590 02/27/2009

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER	
JONES, SCOTT E	
ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
02/27/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASOOD GARAHI, JON C. ZARING,
and PETER C. BOYLAN, III

Appeal 2008-1300
Application 09/630,604
Technology Center 3700

Decided:[1] February 27, 2009

Before HUBERT C. LORIN, DAVID B. WALKER, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

---

[1]The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-86, 89-133, and 135-144. Claims 87, 88, and 134 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a system and method for interactive wagering, and more particularly, to interactive wagering applications with wireless wagering capabilities whereby a wager may be created by selecting a desired racetrack, race, wager type, wager amount, and horse or horses for the wager submitted over wireless links. (Specification 1:9-12, 2:12-15.)

Claims 44 and 90, reproduced below, are representative of the subject matter on appeal.

> 44. An interactive wagering system that provides a user with an opportunity to submit electronic wagers on races that are to be run to computer equipment over a communications network using an interactive wagering application, comprising:
>
> in-home user equipment; and
>
> at least one wireless portable computing device with a display that is in two-way wireless communication with the in-home user equipment, wherein the in-home user equipment and the wireless portable computing device are configured to:
>
> provide the user with on-screen options on the display of the wireless portable computing device that allow the user to create a

wager for a given race to be run, wherein the on-screen options are based at least in part on information received over a wireless communications path between the wireless portable computing device and the in-home user equipment, and wherein the information is based at least in part on racing data received by the in-home user equipment from the communications network; and

allow the user to wirelessly transmit the wager from the wireless portable computing device to the in-home user equipment over the wireless communications path when it is desired to submit the wager for processing; and

transmit the wager from the in-home user equipment to the computer equipment over the communications network for processing.

90. An interactive wagering system that provides a user with an opportunity to wirelessly submit electronic wagers on races that are to be run using an interactive wagering application, comprising:

wireless user equipment having a display, wherein the wireless user equipment is configured to provide the user with on-screen options on the display that allow the user to create a wager for a given race to be run;

computer equipment to which the wagers are submitted over a communications network; and

wireless communications equipment at a track with which the wireless user equipment wirelessly communicates, wherein the wireless user equipment and wireless communications equipment are configured to allow the user to transmit the wager from the wireless user equipment to the communications network via the wireless communications equipment when it is desired to submit the wager for processing and

wherein the computer equipment receives the wager over the communications network for processing.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Lappington	US 5,734,413	Mar. 31, 1998
LaDue	US 5,999,808	Dec. 7, 1999
Brenner	US 6,004,211	Dec. 21, 1999

The following rejections are before us for review.

1. The Examiner rejected claims 1-86 and 91-133 under 35 U.S.C. § 103(a) as being obvious over Brenner in view of Lappington.

2. The Examiner rejected claims 142-144 under 35 U.S.C. § 103(a) as being obvious over Brenner in view of Lappington.

3. The Examiner rejected claims 89, 90, and 134-141 under 35 U.S.C. § 103(a) as being obvious over Brenner in view of LaDue.

ISSUES

Have Appellants shown that the Examiner erred in rejecting claims 1-86 and 91-133 under 35 U.S.C. § 103(a) as being obvious over Brenner in view of Lappington on the grounds that a person with ordinary skill in the art would understand that it was well known at the time of the invention to use a user interface screen with on-screen options in wireless portable computing devices, such as with the portable terminal 122 of Brenner.

Have Appellants shown the Examiner erred in rejecting claims 89, 90, and 134-141 under 35 U.S.C. § 103(a) as being obvious over Brenner in

view of LaDue on the ground that a person with ordinary skill in the art would know from LaDue to locate the user communication system in Brenner at a race track.

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Brenner discloses a

> [u]ser terminal 122, which is preferably microprocessor-based, supports software capable of coordinating the receipt and display of racing data and the placing of wagers electronically. Preferably, user terminals 122 generate easy-to-read menus on displays 126, which may be, for example, conventional television sets. User terminal 122 executes instructions that enable terminal 122 to process the racing data received from distribution facility 120 and display the data on display 126 in a suitable format. The user can interact with user terminal 122 using any suitable user interface, such as a keyboard, pointing device, or voice-actuated controller. Preferably, the user interacts with user terminal 122 using an infrared or other suitable type of wireless remote control.

(Brenner, col. 7, ll. 21-34.)

2. The Examiner found that:

> Brenner et al. does not specifically teach that the wireless remote control device has a screen with on-screen options, but he does teach that any suitable wireless user interface device can be used in conjunction with television sets for display (7:21-34).... [i]t is well known in that art that audio/video remote controllers are wireless multifunctional devices with user interface screens producing user selectable menus. Examples of

> such are devices specifically made as all-in-one audio/video remotes, or personal digital assistants programmed with an extra function of control audio/video systems. With the remotes such as a personal digital assistant (PDA) it also would have been obvious to one skilled in the art at the time to display informational/wager choices on the PDA to allow the race to be displayed on a separate display continuously. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brenner et al. to use the wireless handheld taught by Lapp for the purposes as taught above in addition to reasons taught by Lapp such as view multiple concurrent events without losing scores. This would also allow one to place multiple concurrent bets on different races, releasing the constraints of betting only on a single game at any one time.

(Answer 3-4.)

3. Lappington discloses wireless interactive two-way communication with between in-home user equipment television set 30 and a portable computing device 32 whereby:

> [t]he signal received by satellite receiver 26 is sent to the home viewer where it is received by television set 30 and settop device/converter 28. Television 30 plays the original television program. Settop device 28 receives the encoded television signal and strips out the interactive data. Settop device 28 sends the interactive data by infrared transmission to handheld 32, which presents the interactive program to the home viewer. Thus, while the home viewer watches TV 30, the viewer can participate in the interactive program presented on handheld 32. Although infrared transmission is preferred, any other means for transmission will suffice; for example, radio

> communication or a wire. Transmission via infrared or radio is more efficient than a wire because many viewers, each with their own handheld, can participate simultaneously.

(Lappington, col. 8, l. 62 - col. 9, l. 9.)

4. Lappington discloses

> [a] scripit [(sic)] [which] is a stand alone element that does not require another scripit [(sic)] to function, Examples of scripits [(sic)] include messages, questions, responses, criteria, and tables (to be explained below). An aggregate of scripits [(sic)] make up a script.
>
> A transaction is the compiled version of a scripit or group of scripts which is time oriented. That is, all the data for a transaction is sent to handheld 32 at one time. Examples of transactions include messages, questions, responses, scoring criteria, branching conditions or a combination thereof. A group of one or more transactions make up a segment. A segment is a group of transactions that must be played sequentially. For example, a segment may include a transaction asking a question, a transaction disclosing the correct answer, a transaction scoring the viewer's response, a transaction providing the viewer with feedback or a combination thereof. Each transaction is numbered so that the first transaction in a segment is assigned a transaction number of one.

(Lappington, col. 10, ll. 8-26.)

5. Lappington discloses a hand held which displays:

> messages, questions, and responses. Messages are text displayed on handheld 32 that do not require input from the viewer. Messages can introduce a show or provide information about the program. For example, a message may state, "Hello,

> welcome to the Super Bowl." Questions are text that request input from the viewer. There are preferably six types of questions: Yes/No, True/False, Multiple Choice, Integer, Decimal, and Fill In The Blank.

(Lappington, col. 11, ll. 25-33.)

6. The Examiner found that:

> LaDue teaches the use of a wireless application protocol for use in wireless gaming and wagering (Abstract) for the purpose of operating seamlessly with existing wireless networks without need for further modification (2:26-29). LaDue also teaches the use of a handheld computer for communication with the wagering/gaming system with a built in screen capable of displaying users selectable menus (Fig 9). It would have been obvious to one skilled in the art at the time the invention was made to combine the wireless application protocol system for wagering by LaDue with the horse race wagering system as taught by Brenner et al. for the purpose of seamless operation with the existing wireless network infrastructure and so that wagering can take place anywhere legal including the race track or in a user's home.

(Answer 7.)

7. LaDue discloses

> a preferred methodology for wireless gaming and gambling … where[by] a CCAD communicator receives a message, such as gaming data, wagers, rules, or the like, from a paging network 219, and the CCAD communicator reads a received paging message 220. Communicator 100 evaluates the message, whether its an alpha/numeric message or coded instructional message 221, and responds or

> does not respond 222, to the received message from paging network 219…. This aforementioned protocol process may be used for all manner of gaming, wagering, and other application specific messaging and operates in this general manner with all cellular air interface and network standards.

(LaDue, col.7, ll. 40-48; col. 8, ll. 22-26.)

8. LaDue discloses that the "…game caddy can be configured as a dual mode cellular transceiver and can operate both in analog and digital platforms. The game caddy can also contain a differential GPS receiver. This feature is necessary for gaming casinos to track the assigned user. (LaDue, col. 10, ll. 52-54.)

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

ANALYSIS

We affirm the rejections of claims 1-86, 89-133, and 135-144.

Rejection of Claims 1-86 and 91-133 under 35 U.S.C. § 103(a)

Initially, we note that the Appellants argue these claims together as a group. Correspondingly, we select representative claim 44 drawn to the system to decide the appeal of these claims, remaining claims 1-43, 45-86, and 91-133 standing or falling with claim 44. *See,* 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Appellants argue that

> if the wagering screens of Brenner were to be implemented on handheld 32 of Lappington, then the wagering screens of Brenner would have to be displayed as text. As a result, none of the graphical objects displayed in the wagering screens of Brenner would be able to be displayed on handheld 32 of Lappington.

(Appeal Br. 9.)

However, Appellants' argument does not accurately portray the modification which the Examiner proposes. What the Examiner proposes is "to modify Brenner et al. [and not Lappington] to use the wireless handheld taught by Lapp" in Brenner (FF 2). Thus, the argument is not persuasive of error because the Examiner is not proposing modifying Lappington as Appellants assert thereby making Appellants' arguments moot as to this point.

In modifying Brenner, the Examiner only proposes including on screen options on Brenner's wireless terminal 122 as disclosed by Lappington (FF 2). It is undisputed that Brenner discloses an easy to read graphical user interface allowing the user to place wages on a horse through

his/her in home television equipment (Appeal Br. 8-9). The graphical user interface in Brenner is also wireless (FF 1). The Examiner found "[i]t is well known in that art that audio/video remote controllers are wireless multifunctional devices with user interface screens producing user selectable menus." (FF 2.)[2] Lappington evidences the known use of such on-screen options with its handheld 32, which has a display having plural screen options. (FF 3, 4, 5.) Appellants do not contest this aspect of Lappington. The options in Lappington are defined by transactions "[which] include messages, questions, responses, scoring criteria, branching conditions or a combination thereof (FF 4). A group of one or more transactions make up a segment." (FF 4, 5.) Thus, we agree with the Examiner that a person with ordinary skill in the art would have known to modify the portable terminal 122 of Brenner to include on-screen options since on screen option were known at the time of the invention as evidenced by Lappington.

What Appellants do challenge, however, is even if the combination could be made, it would be problematic because 1. Lappington's display 398 is a "...relatively small display [which] would not be capable of displaying all of the information displayed in Brenner's wagering screens" and 2. the scroll bars of Lappington's; hand held 32 "would be cumbersome for users to operate… to view information on the wagering screens." (Appeal Br. 10.)

[2] The record indicates Appellants requested evidence of such known use as provided for under *The Manual of Patent Examining Procedure* (MPEP) § 2144.03 (*See* Response dated May 21, 2002 at 23), and the Examiner responded by providing Lappington as evidence to such request in the Final Office Action dated August 26 2002 at 6.

Again, Appellants' argument wrongly identifies Lappington as the modified reference when the Examiner proposes modifying Brenner (FF 1), and thus the argument is not persuasive of error. But, assuming Appellants did argue the combination correctly, the argument fails because "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

In their pre-*KSR* Brief, Appellants further argue that "the Examiner has failed to provide a proper motivation for combining Brenner and Lappington to justify the assertion of a § 103 rejection." (Appeal Br. 11-16.) To the extent Appellants seek an explicit suggestion or motivation in the reference itself, this is no longer the law in view of the Supreme Court's recent holding in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Since the Examiner has provided some articulated reasoning with some rational underpinning and attendant evidence for why a person with ordinary skill in the art would modify Brenner to include on screen options on its portable terminal 122 (FF 2), Appellants' argument is not persuasive as to error in the rejection. Thus, for the above reasons, we sustain the rejection of claim 44 based on Brenner and Lappington.

Rejection of Claims 142-144 under 35 U.S.C. 35 U.S.C. § 103(a)

Appellants' Brief refers to their arguments advanced above directed to independent claims 1, 44 and 91 for claims 142-144. (Appeal Br. 7) We therefore sustain the rejection of these claims for the same reasons set forth above with respect to claims 1-86 and 91-133.

Rejection of Claims 89, 90, and 134-141 under 35 U.S.C. § 103(a)

Initially, we note that the Appellants argue claims 89, 90, and 134-141 together as a group. Correspondingly, we select representative claim 90 drawn to the system to decide the appeal of these claims, remaining claims 89 and 134-141 standing or falling with claim 90. *See,* 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Appellants argue that

> the combination of Brenner and LaDue fails to show or suggest "allowing the user to transmit the wager from the wireless user equipment to a communications network via communications equipment at a racetrack that communicates wirelessly with the wireless user equipment" (emphasis added), as required by independent claims 89, 90, and 135. In particular, neither Brenner nor LaDue discusses communications equipment located at a racetrack for communicating wirelessly with wireless user equipment.

(Appeal Br. 18.)

The Examiner found:

> LaDue also teaches the use of a handheld computer for communication with the wagering/gaming system with a built in screen capable of displaying users selectable menus (Fig 9). It would have been obvious to one skilled in the art at the time the invention was made to combine the wireless application protocol system for wagering by LaDue with the horse race wagering system as taught by Brenner et al. for the purpose of seamless operation with the existing wireless network infrastructure and so that wagering can take place anywhere legal including the race track or in a user's home. [(FF 6.)]

We agree with the Examiner.

Claim 90 requires "wireless communications equipment at a track with which the wireless user equipment wirelessly communicates."

We determine that the Examiner's finding is reasonable because Ladue discloses its user wireless equipment may be used "for all manner of gaming and wagering…" (FF 7) and even discloses the user wireless equipment includes a differential GPS receiver in the hand held game caddy "necessary for gaming casinos to track the assigned user." (FF 8.) Accordingly, we infer from LaDue that since the gaming establishment assigns and tracks users of its wireless user equipment at the casino, the communication equipment which communicates with the game caddy can also be there. *See KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ"). Moreover, since LaDue discloses its system may be used for all manner of gaming and wagering, and its wireless system is reasonably likely to be located, and facilitates wagering at one wagering site, e.g., a casino, then a person of ordinary skill in the art would recognize that the equipment would facilitate wagering at other wagering venues, such as a race track, in the same way. "For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *KSR* at 1740. Accordingly, we sustain the rejection of claim 90.

CONCLUSIONS OF LAW

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 1-86 and 91-133 under 35 U.S.C. § 103(a) as being obvious over Brenner in view of Lappington, claims 142-144 under 35 U.S.C. § 103(a) as being obvious over Brenner in view of Lappington, and claims 89, 90, and 134-141 under 35 U.S.C. § 103(a) as being obvious over Brenner in view of LaDue.

DECISION

The decision of the Examiner to reject claims 1-86, 89-133, and 135-144 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

hh

ROPES & GRAY, LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704